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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,247	12/06/2001	Juergen A. Kortenbach	SYN-064B	5785
24131	7590	07/14/2006	EXAMINER	
LERNER GREENBERG STEMER LLP			EREZO, DARWIN P	
P O BOX 2480			ART UNIT	
HOLLYWOOD, FL 33022-2480			PAPER NUMBER	
			3731	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/010,247	Applicant(s) KORTENBACH ET AL.	
	Examiner Darwin P. Erez	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 33-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-24 and 33-40 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 5 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6-11, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,049,153 to Nakao et al.

Nakao teaches a surgical clip applier, as shown in Fig. 18, comprising a hollow member **140** having a distal end with a clevis/jaw mount **162**; a first jaw **158** that rotatably couples to the clevis (via lever **156**); a second jaw **160** that is also rotatably coupled to the clevis but in opposed relation (facing each other); wherein the first and second jaws have a longitudinal extent; wherein the first and second jaws have a channel (**166,168**) along said longitudinal extent for guiding and slidably applying a clip **174**; the applier further comprising a pull/push wire/rod **142** coupled to the first and second jaws (via levers **145,156**); and actuation means for moving the rod/wire **162** (manipulation of rod **162** would be similar to the actuation mechanism embodiment shown in Fig. 4A-4I); wherein the both jaws are provided with teeth (**173, 175**); wherein the distal end of each jaw has a hook shaped anvil (Fig. 18); wherein both jaws include said channel and hook (Fig. 18); wherein the anvil has a curved surface since the distal end of each jaw is curved; wherein said surface is curved about a single axis (see Fig. 18); wherein the dimension of each jaw includes a longitudinal axis and a vertical axis

perpendicular to the longitudinal axis; and each channel is arranged an angle relative to the vertical axis; wherein a portion of the channel that is curving up in the distal end would be approximately 22 degrees at a given point.

***Allowable Subject Matter***

3. Claims 5 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims 15-24 and 33-40 are allowed over the prior art of record.

***Response to Amendment***

5. Applicant's arguments filed 4/20/06 have been fully considered but they are not persuasive.

6. The applicant's main argument regarding the rejection above is that the Nakao reference allegedly failing to teach "the first and second jaw adapted to slidably apply a surgical clip with the first and second clip guiding channels". However, this limitation merely requires that the guide channels are capable of slidably applying a surgical clip. With regards to the Nakao reference, a clip is applied to the tissues by maneuvering the jaws to the closed position. When the clip is released from the jaws, the clip is fully capable of sliding out of the guide channel upon release. That is, a fully locked clip within the guide channels is capable of sliding out of the guide channels when the clip applier is removed. It is also noted that this application does not go in depth with regards to the deployment of the clip from the clip applier. A general search of the specification with the term "slide or slidably" did not produce any results. Furthermore,

the limitation the applicant is arguing is merely an intended use of the clip applier, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As viewed above, the guide channels of Nakao are fully capable of allowing a locked clip to slide out once applied.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erezzo whose telephone number is (571) 272-4695. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**ANH TUAN T. NGUYEN**  
**SUPERVISORY PATENT EXAMINER**

2/7/06